

Remarks

In the present application, claims 1, 3-11, 13, 16-19, 21-23, 34, 39, 44 and 46-47 are pending. Claims 1, 3-11, 13, 16-19, 21-23, 34, 39, 44 and 46-47 are rejected. Claims 2, 12, 14-15, 20, 24-33, 35-38, 40-43 and 45 have been previously canceled.

Claim Rejection - 35 U.S.C. § 103(a)

The Examiner has rejected claims 1, 3-11, 13, 16-19, 21-23, 34, 39, 44 and 46-47 as being unpatentable under 35 U.S.C. § 103(a) over Gabor et al. (U.S. Patent Publication No. 2004/0203710), herein Gabor, in view of Kastelewicz et al. (U.S. Patent Publication No. 2004/0153667), herein Kastelewicz. The Applicant includes the following comments to clearly distinguish the claimed invention over the art cited by the Examiner, and respectfully requests a favorable reconsideration of claims 1, 3-11, 13, 16-19, 21-23, 34, 39, 44 and 46-47.

These rejections are respectfully disagreed with, and are traversed below.

It is noted that Gabor has a publication date of October 14, 2004 and the instant application has a priority date of October 21, 2003 which predates the publication of Gabor. Thus, Gabor qualifies as prior art under 35 U.S.C. § 102(e). Additionally, an assignment of Gabor to Nokia Corporation was recorded on February 10, 2003 (see Reel 013753, Frame 0197). The instant application is also assigned to Nokia Corporation (see Reel 018604, Frame 0644). Thus, the instant application and Gabor were, at the time the invention of the instant application was made, commonly owned.

35 U.S.C. § 103 (c) states:

“(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, **owned by the same person or subject to an obligation of assignment to the same person**” (emphasis added, see also MPEP §706.02(l)(2)).

Since Gabor qualifies as prior art only under “subsections (e)... of section 102” and Gabor and the instant application are co-owned, Gabor does not qualify as prior art for a rejection under 35 U.S.C. § 103(a). Therefore the rejection under 35 U.S.C. § 103(a) based on Gabor and Kastelewicz is improper and should be withdrawn.

The Examiner is respectfully reminded that, in accordance with the MPEP, the Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Examiner must ascertain the differences between the claimed invention and the prior art. However, the gap between the prior art and the claimed invention may not be so great as to render the claim nonobvious (see MPEP § 2141-2142).

Regarding claim 1, which recites:

“A method, comprising:
receiving at a first network element in a communications network a first message from a user equipment;
transmitting the first message from the first network element to a serving network element;
detecting at the first network element that the serving network element is out of service;
determining at the first network element a type of the first message, wherein determining the type of the first message comprises evaluating content of a predefined information element in the first message;
in response to detecting at the first network element that the serving network element is out of service and to determining that the type of the first message is a re-registration request, sending from the first network element to the user equipment an error message including an indication that the serving network element is out of service; and
subsequent to sending the error message to the user equipment, receiving a second message having an initial registration type from the user equipment”.

As noted in the “Arguments for a Pre-Appeal Brief Conference Request for Review” filed January 27, 2011, Kastlewicz does not disclose or suggest “detecting at the first network element that the serving network element is out of service” and/or “in response to detecting at the first network element that the serving network element is out of service and to determining that the type of the first message is a re-registration request, sending from the first network element to the user equipment an error message including an indication that the serving network element is out of service” as in claim 1. As Kastlewicz does not disclose or suggest all elements of claim 1, claim 1 is not made obvious by Kastlewicz. For at least this reason, claim 1 is in condition for allowance.

As claims 19, 21, 34, 39, 44 and 47 recite similar language to that discussed above with reference to claim 1; claims 19, 21, 34, 39, 44 and 47 are likewise in condition for allowance. Claims 3-11, 13, 16-18, 22-23 and 46 depend upon claims 1, 19 and 21. For at least this reason, they are likewise in condition for allowance.

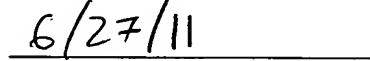
In light of the discussion above, the Applicant respectfully asserts that a prima facie case for obviousness was not presented. As such, the Applicant respectfully requests that the Examiner reconsider and withdraw these rejections to claims 1, 3-11, 13, 16-19, 21-23, 34, 39, 44 and 46-47.

For the foregoing reasons, the Applicant believes that each and every issue raised by the Examiner has been adequately addressed and that this application is in condition for allowance. As such, early and favorable action is respectfully solicited.

Respectfully submitted:



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